

REMARKS

Claims 1 through 9 and 12 through 15 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Toguchi et al.

In the statement of the rejection the Examiner asserted, but did not show, that Toguchi et al. disclose an electroluminescent device corresponding to that claimed. The Examiner made no mention of any disclosed impurity limitations, presumably because Toguchi et al. do not disclose any impurities or any impurity limitation. The Examiner then went on to commit clear legal error by reading out express limitations from the claims in order to facilitate examination. This rejection is traversed as factually and legally erroneous.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of **each** element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). In imposing a rejection under 35 U.S.C. § 102 the Examiner is required to **specifically identify** wherein an applied reference is perceived to identically disclose each and every feature of a claimed invention, particularly where such is not apparent as in the present case. *In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984). That burden has **not** been discharged. Indeed, there is a significant difference between the claimed devices and the device disclosed by Toguchi et al. that scotch the factual determination that Toguchi et al. disclose a device identically corresponding to those claimed.

Initially, the Examiner committed **legal error** in asserting that the claims do not positively recite the addition of copper, aluminum, nickel, or iron atoms, and that the recited amounts include zero. That this interpretation of the claimed inventions is erroneous is apparent because claim 1 **specifically recites** that: "... said organic compound layer **contains** copper atoms". Repeat "**contains copper atoms**". Simply because a minimum amount of the impurities was not recited, is no excuse to read out of the claims the **positive limitation** that the "said organic compound layer **contains copper atoms**". Similarly, claim 4 **specifies** that "... said organic compound layer **contains aluminum atoms**". Claim 6 **specifies** that "... said organic compound layer **contains iron atoms**". Claim 8 **specifies** that "... said organic compound layer **contains nickel atoms**." Claim 12 **specifies** that "... said organic compound layer **contains iron atoms**." Claim 14 **specifies** that "... said organic compound layer **contains nickel atoms**."

As one having ordinary skill in the art would have recognized, the claimed invention **requires** the organic compound layer to contain the recited metallic atom impurities, but imposes a **maximum limitation** on the amount of the impurities present. The impurities are **present** but limited as to the maximum permissible amount. The MPEP, which does not have the force and effect of law, cannot override, in the abstract, positively recited claim limitations.

As previously pointed out, Toguchi et al. are **silent** with respect to impurities. Silence in a reference is no substitute for the requisite factual basis to support the imposed rejection. *In re Burt*, 356 F.2d 115, 148 USPQ 548 (CCPA 1966).

Moreover, the silence in Toguchi et al. with respect to impurities is particularly fatal in the present case, because the maximum imposed limitation on the recited impurities is not a matter to be taken lightly. As disclosed in the paragraph bridging pages 3 and 4 of the written

description of the specification, it was the result of experimentation and examination that led to the **discovery** that **particular** metal impurities in the organic compound layer caused significant deterioration in carrier transport capability, leading to deteriorated luminescent characteristics. The present invention addresses and solves that problem by controlling the maximum amount of these particular impurities in the organic compound layer. That concept is not even a blip on the radar screen of Toguchi et al.

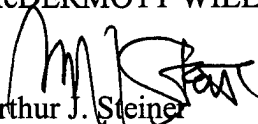
The above argued differences between the claimed devices and the device of Toguchi et al. undermine the factual determination that Toguchi et al. disclose a device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1 through 9 and 12 through 15 under 35 U.S.C. § 102 for lack of novelty as evidenced by Toguchi et al. is not factually or legally viable and, hence, solicit withdrawal thereof.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Application No.: 10/813,624

Respectfully submitted,

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